

Application No.: 10/668,736

Case No.: 58725US002

REMARKS

Claims 19 - 25 are pending. Claims 22-25 have been amended.

As a preliminary matter, Figures 3 and 8 stand objected to as failing to comply with 37 CFR 1.84(p)(5) for including reference characters 345, 355, and 820 not mentioned in the description. Applicants have amended the specification paragraph beginning on page 15, line 28, to clarify that reference character 820 is an abrasive article. Applicants have also amended the specification paragraph beginning on page 23, line 2, to clarify that reference characters 345 and 355 are the vertices of their respective abrasive features 346 and 356. No new matter has been added. In view of Applicants' amendment, Applicants respectfully request that these objections be withdrawn.

I. Claims 19-25 are Enabled under 35 U.S.C. § 112, First Paragraph

Claims 19-25 stand rejected under 35 U.S.C. § 112, first paragraph, as alleging being based on a disclosure that is not enabling. The Office Action submits that the binder, grinding aid and the abrasive particles, as defined on page 13, lines 15-17 are critical or essential to the practice of the invention but not included in the claims. Applicants respectfully disagree.

The specification states at page 13, lines 15-17:

An essential step to make any of the inventive abrasive articles is to prepare the slurry. The slurry is made by combining together by any suitable mixing technique the binder precursor, the grinding aid, the abrasive particles and the optional additives.

The cited section clearly states that "[a]n essential step ... is to prepare the slurry." The cited language, however, does not state that grinding aids are essential. One skilled in the art reading the cited language would, at most, understand the preparation of a slurry to be an essential step in making the abrasive article, and that the slurry may comprise the combination of a binder precursor, a grinding aid, and abrasive particles. Further, as discussed at page 9, line 10, through page 10, line 29, one skilled in the art would recognize the added benefits of adding a grinding aid to the slurry, but that doing so would not be essential to creating a useful abrasive feature embodying the claimed invention.

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Applicants respectfully maintain that claims 19-25 are enabled under 35 U.S.C. § 112, first paragraph, and the rejection should be withdrawn.

II. Claims 22-25 are Definite under 35 U.S.C. § 112, Second Paragraph

Claims 22-25 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. The Office Action submits in part that: claims 22, 23, and 24 are indefinite for their reference to abrasive "articles" when the claimed elements are not applied to a backing. Per the Examiner's suggestion, Applicants have amended claims 22-25 to claim methods for making abrasive features.

The Patent Office also submits that claims 23 and 24 are indefinite because they do not define when the recited step takes place. Applicants disagree that a temporal limitation is necessary under 35 U.S.C. § 112, second paragraph. However, in an effort to further prosecution, Applicants have amended claims 23 and 24 to specify when the recited steps take place.

Finally, the Office Action alleges that claim 25 is indefinite because it defines "curing out of the tool", but does not define a removal step. Applicants have amended claim 25 as suggested to clarify that the curing out of the tool occurs following removal from the tool.

In light of the above amendments and explanations, Applicants submit that claims 22-25 comply with the requirements of 35 U.S.C. § 112 and respectfully request that the rejections be withdrawn.

III. Obviousness-type Double Patenting

Claims 19-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 22, 23, and 34 of copending Patent Application No. 10/668,753. As of the date of the filing date of the instant paper, Patent Application No. 10/668,753 has not received a notice of allowances. Accordingly, Applicants request that this rejection be held in abeyance until patentable subject matter is indicated.

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IV. Conclusion

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. The Examiner is invited to contact Applicant's undersigned representative with any questions concerning Applicant's application.

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Date

Respectfully submitted,

By: 
Daniel D. Biesterveld, Reg. No.: 45,898
Telephone No.: 651-737-3193

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833